

provided the serial numbers for the various applications incorporated by reference as requested by the examiner. Entry of all these amendments is respectfully requested.

Reconsideration of the rejection of the claims 1-3 under the judicially created doctrine of obviousness-type double patenting. As previously noted, because of the prior restriction requirement, there is absolutely no proper basis for such a rejection. The Patent and Trademark Office cannot first claim that these claims are distinct for purposes of imposing a restriction requirement and thus force the applicant to limit his claims and cancel the nonelected claims and then later claim that these same claims are not distinct when a divisional application is filed on them. The rejection must be withdrawn for this reason alone, in addition to the other reasons previously asserted.

Although the applicant is surprised that the Examiner repeated an obviously unsupportable double patenting rejection even after being informed of these facts and had an opportunity to examine the record in the Patent Office. For purpose of record on appeal, attached is the requested copy of the Office Action of March 4, 1997 in which claims 36, 37 and 38 were made subject to a restriction requirement. Can the examiner still deny these facts?

Claim 4-6 are the identical method counter-parts of the apparatus claims 1-3, and thus if claims 1-3 are barred from a double patenting rejection then claims 4-6, must also be barred. Withdrawal of the double patenting

rejection for all claims and not only claims 1-3 is therefore requested.

Withdrawal of the finality of the rejection is requested. The reason given for the finality was that the applicant's amendment necessitated the new grounds of rejection, when, in fact, in the same action it is stated that

" On page 1 of the Amendment: The changes to claims 36-38 were not entered because claims 36-38 does not exists in this instant application."

Although, claims 4-6 were added by amendment, as noted above, they are merely the identical method counter parts of claims 1-3. There is no new ground of rejection. The old grounds of rejection that were not overcome were double patenting and anticipation by Hill et al. (US 4,034,210); The so-called "new grounds" of rejection are double patenting over U.S. Patent No. 5,494,544 and anticipation under Section 102 by Hill et al. (US 4,034,210). Thus, in fact, the "old" and the "new" are one and the same. There is therefore no basis to make this action final because there are "new grounds" of rejection.

Reconsideration of the repeated rejection of the claims under 35USC102(B) as being anticipated by Hill et al. (U.S. patent 4,034,210) is respectfully requested for the same reasons set forth in the remarks to the last amendment. A rejection under Section 102 requires that each and every one of the elements of the claim appear in the references. As previously explained in detail, there are

three elements of the claim that are lacking from the reference:

"Thus, as illustrated above, the Hill et al. '210 patent completely lacks three features of claim 1, each of which is critical to the invention: (1) Hill et al. '210 lacks any means whatsoever for producing cards (only making match-mismatch determinations), as specified in the preamble); (2) Hill et al. lacks any means for determining whether a card has been "incorrectly prepared" (only making mismatch determinations), as specified in the second element of the claim; and (3) there are no means for preventing an "incorrectly prepared card" (i.e. the card that is being prepared by the card package production system) from being inserted into a carrier, as specified as the second element of this claim. Accordingly, there is no possibility that the Hill reference can anticipate any of the claims under 35UCS102(a). There is absolutely no support for the rejection of these claims on this basis, and withdrawal of the rejection on this basis is therefore respectfully requested. Withdrawal of the rejection is therefore respectfully requested."

The examiner has not denied that there are three elements that are entirely lacking from the reference, and thus the existence of these elements should be taken as admitted. Accordingly, in effect, it is admitted that there is no basis for repeating the rejection that was obviously overcome by the applicant's remarks. If not, then even the briefest reading of the Hill et al. reference would demonstrate these distinguishing facts to anyone having

interest in knowing the truth. It is not appropriate to simply ignore the applicant's remarks and the truth that they speak. Nothing is gained by merely repeating a rejection that has already been shown to be based on erroneous assertions of elements present in a reference or a denial of express limitations in the claims. The rejection should be withdrawn and the claims allowed, or the examiner should provide a basis for the rejection other than the erroneous assertion of which he has doubly been made aware.

Since repetitive errors cannot ever lead to a resolution, the applicant is not optimistic and rather than file a continuing prosecution application to resolve these issues which they would do if progress could be seen, they feel they must appeal. Accordingly, a notice of appeal is being filed contemporaneously with this response.

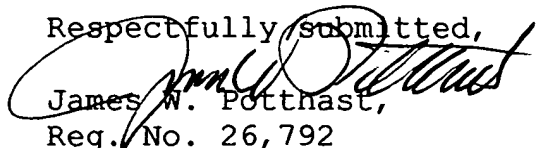
Nonetheless, reconsideration and allowance of all claims, claims 1-6, are therefore respectfully requested. In any event, entry of the above house-keeping amendments is requested.

If the examiner is still having difficulty understanding anything stated here or previously, the undersigned would be pleased to respond to a call for an interview to provide further explanation

Please note that enclosed change of address form being

filed herewith and the new telephone numbers noted below.

Respectfully submitted,


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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service, First Class, postage prepaid, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 this 23rd day of October, 2000.

Date: Oct 23, 2000


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